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*In re Application of:*

Bornstein, Eric

Serial No.: 10/649,910

Filed: Aug. 26, 2003

Docket: borne40565

DECISION ON PETITION

Title: NEAR INFRARED MICROBIAL  
ELIMINATION LASER SYSTEM

This is a decision on the petition filed on Jul. 16, 2007 by which petitioner requests withdrawal of the restriction requirement mailed Dec. 29, 2006, and that non-elected claims 1-20 be rejoined and examined on the merits. Claims 21-22 were elected and examined. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

Discussion and Analysis

A review of the record reveals that a restriction requirement was issued on Dec. 29, 2006 between two disclosed and claimed related inventions: I) a laser system (claims 1-20) and II) a method of destroying bacteria (claims 21-22). Currently as the record stands, the issue of the propriety of the restriction requirement in the petition remains with the Group I invention and the Group II invention.

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. The inventions can be shown to be distinct if either or both of the following can be shown: that if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process, MPEP 806.05(e)<sup>1</sup>.

In the instant application, the distinctness between the claimed inventions was justified as stated in the examiner's restriction requirement of Dec. 29, 2006 in that the apparatus claims could be used to illuminate tissue to determine the degree of oxygen saturation of the blood therein. While

<sup>1</sup> M.P.E.P. §806.05(e) [R-5] Process and Apparatus for Its Practice: Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process.

it appears that the examiner has technically satisfied the one-way distinction requirement set forth in MPEP § 806.05(e), this section further states that the distinction must be based on the apparatus *as claimed*.

In the petition, petitioner alleges the examiner failed to consider all of the limitations present in the pending claims and ignored the plain text of the claims at issue. Petitioner also alleges the near infrared laser(s) of the claimed system are not used for illumination purposes in contrast with the examiner's example given in the restriction.

While the examiner has provided another method for using the apparatus defined by claims 1 and 11, the method fails to take into account that the apparatus claims define the same method as the process claims 21 and 22. While this method need not be explicitly taught by a prior art apparatus structure to result in a possible anticipation or obviousness rejection of the apparatus claims (see MPEP 2114), the language must be taken into account for purposes of a restriction requirement. The examiner has failed to do this. Under the circumstances, the restriction requirement of Dec. 29, 2006 is hereby withdrawn. The examiner is directed to consider the amendment filed on Aug. 15, 2007 along with the non-elected claims 1-20 not inconsistent with the present decision.

#### Conclusion

In view of the fact that the elected claims and the non-elected claims have a scope co-extensive to each other and the lack of showing of any serious search burden, the restriction requirement promulgated in the Office communication dated Dec. 29, 2006 is withdrawn. The relief requested in the petition is granted.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3735 for further consideration of all pending claims in the amendments filed on Aug. 15, 2007. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

Petition granted.

for Karen H. Young  
Frederick R. Schmidt, Director  
Technology Center 3700